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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/914,584 | 12/11/2001 | Leopold Flohe | 2727-155 | 7821 |
| 20999 | 7590 | 04/07/2004 | EXAMINER | |
| FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151 | | | SAUCIER, SANDRA E | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1651 | |

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|-----------------|--------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/914,584 | FLOHE ET AL. |
| | Examiner | Art Unit |
| | Sandra Saucier | 1651 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 20 October 2003 and 10 February 2004.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-7 is/are pending in the application.

4a) Of the above claim(s) 1-4 and 7 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 5 and 6 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 11 December 2001 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Claims 1–7 are pending. Claims 5 and 6 are considered on the merits. Claims 1–4 and 7 are withdrawn from consideration as being drawn to a non-elected invention.

The Office Action mailed 1/12/04 has been withdrawn. The Office erred in entering a preliminary amendment filed 12/23/04 into the instant application. The preliminary amendment was intended for entry into another application. If applicant now knows the assigned application number of the new application, it is suggested that another preliminary amendment be submitted with the application number of the new case.

Please remember to present a list of pending claims with the next response.

Claim Rejections – 35 USC § 112

Claims 5 and 6 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Claims 5 and 6 claim compounds that are not disclosed in the body of the specification. Lack of disclosure of the identity of the compounds by means of elements such as structure which properly identify compounds, and which instead are claimed by functional features, is not sufficient description to show possession of the compounds at time of filing.

Response to Arguments

Applicant's arguments filed 12/23/03 have been fully considered but they are not persuasive.

Applicants argue that *In re Edwards*, 568 F.2d 1349 is the pertinent case law with regards to written description and enablement. However, the

examiner considers the pertinent case law to be *University of Rochester v. G.D.Searle & Co.*, 68 USPQ2d 1424 (DC WNY 2003). “The inventor must be able to describe the item to be patented with such clarity that the reader is assured that the inventor actually has possession and knowledge of the unique composition that make it worth of patent protection. The patent at issue here does not do that. What the reader learns from this patent is a wish or plan or first step for obtaining a desired result....As the Court of Appeals for the Federal Circuit state in a case involving similar issues, an inadequate patent description that merely identifies a plan to accomplish an intended result “is an attempt to preempt the future before it has arrived.” *Fiers v. Revel*, 984 F.2d 1164, 1171 [25 USPQ2d 1601] (Fed. Cir. 1993).”.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1651. The supervisor for 1651 is M. Wityshyn, (703) 308-4743. The normal work schedule for Examiner Saucier is 8:30 AM to 5:00 PM Monday and Tuesday and 8:30 AM to noon on Wednesday.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Saucier whose telephone number is (703) 308-1084. Status inquiries must be directed to the Customer Service Desk at (703) 308-0197 or (703)-308-0198. The number of the Fax Center for the faxing of official papers is (703) 872-9306.



Sandra Saucier
Primary Examiner
Art Unit 1651
April 6, 2004